

### **REMARKS**

The present amendment is submitted in response to the Office Action mailed November 3, 2005. In that Office Action, the Examiner raised issues concerning: a previously-filed Information Disclosure Statement, an objectionable informality included in a previously-filed Preliminary Amendment, and an objectionable informality included in claim 2. The Examiner also rejected claim 2 under 35 U.S.C. § 102(b), and rejected claims 1 and 3-6 under 35 U.S.C. § 103. The following Remarks are intended to address each of these matters.

In addition, new claims 7-9 have been added.

#### **1. Information Disclosure Statement**

The Examiner noted that the Information Disclosure Statement filed on March 10, 2005 contained incorrect United States Patent Document numbers. A corrected version of the Information Disclosure Statement is included with this Amendment. Applicant expresses thanks to the Examiner for her location and consideration of the correct references that were intended to be listed in the previously-filed document.

#### **2. Specification**

The Examiner objected to a portion of the amendment to the specification contained in the Preliminary Amendment filed in November of 2003. The objectionable material has been corrected by the amendment to the specification contained in this Amendment.

**3. Claim Objections**

The Examiner objected to claim 2 because the word "extend" on page 9, line 3 should be changed to "extent." This change has been made by the amendment to claim 2 contained in this Amendment, thereby complying with the Examiner's objection. No new matter has been added, nor has the scope of the claim been changed by this amendment.

**4. Claim Rejections – 35 U.S.C. § 102**

Claim 2 was rejected under 35 U.S.C. § 102(b) as being anticipated by Simpson et al. (US 6,126,635). Applicant requests reconsideration and withdrawal of this rejection.

Specifically, claim 2 recites a catheter system that includes "a catheter and a guide wire," in which the guide wire has:

a second expandable occlusion device associated therewith and being adapted to expand said second occlusion device distally of the first occlusion device on the first catheter.

The Simpson patent, on the other hand, does not disclose, teach, or suggest a guide wire having "an expandable occlusion device associated therewith." The only teaching of a guide wire contained in the Simpson patent is in connection with the embodiment shown in FIG. 10, in which the guidewire (156) is slidable within the infusion lumen (138) of the inner catheter (112). No occlusion device is shown associated with the guidewire.

In the Office Action, the Examiner improperly refers to the catheter (12) shown in Figure 1 of the Simpson patent as a "catheter/guidewire." But nowhere does the Simpson patent state that the catheter 12 can or should function as a guidewire in the described device. Instead, the Simpson patent describes the use of a "guiding catheter" that can be used to properly locate the catheter

system, (see Col. 6, ll. 24-31), thereby avoiding the need for a guide wire. Thus, there is no basis for characterizing the inner catheter 12 of the Simpson et al. device as a "guide wire."

Accordingly, because the Simpson et al. patent does not disclose, teach, or suggest every limitation of claim 2, Applicant respectfully requests withdrawal of the rejection of that claim.

**5. Claim Rejections – 35 U.S.C. § 103**

Claims 1 and 3-6 were rejected under 35 U.S.C. § 103 for obviousness over the Simpson et al. patent in view one or more of the following: USP 5,728,062 to Preissman et al., USP 6,102,929 to Conway et al., and US 2002/0026217 to Baker et al. Applicant requests reconsideration and withdrawal of these rejections as well.

Beginning with claim 1, the Examiner correctly notes that the Simpson et al. patent does not describe a device in which at least one of the catheters has "a relatively stiff proximal region, a softer intermediate region and a still softer distal region," as recited in claim 1. The Examiner refers to the Preissman et al. patent for this teaching, but fails to state any basis or grounds by which a person of skill in the art would have been motivated to combine the Simpson et al. and Preissman et al. patents. In order to establish a prima facie case of obviousness, the Examiner must show why someone of skill in the art would be motivated to combine the specific teachings of the cited references in the manner relied upon. Here, that means that the Examiner must show some teaching that would have motivated a person of skill in the art to combine the regions of the catheter having increasing degree of flexibility described in the Preissman et al. patent, with the dual catheter / dual occlusion device structure described in the Simpson et al. patent, and to do so without regard to any of the contrary teachings contained in those references. It is not enough to simply pick and choose

these features from the reference disclosures and state that they represent desirable "improvements" and that, therefore, one would have been motivated to make the combination. See, e.g., WMS Gaming, Inc. v. International Game Technology, 184 F.3d 1339, 1359 (Fed. Cir. 1999). Against this standard, the Examiner has failed to demonstrate a prima facie case of obviousness, because such a showing cannot be made on the basis of these varied references. There simply is no teaching available, either from the references or elsewhere, that would supply the motivation to make the combination relied upon by the Examiner. Accordingly, Applicant respectfully requests withdrawal of the claim rejections made in reliance on combinations of these references.

The rejections of claims 3-6 rely upon the same combination of Simpson et al. and Preissman et al., and therefore suffer from the same defect. In addition, the Examiner has failed to identify any teaching that would have motivated a person of skill in the art to combine the teachings of the Conway et al. and/or Baker et al. patents with the underlying teachings of the Simpson et al. and Preissman et al. patents. In particular, the Conway et al. "Prostatic Tissue Expander" and the Baker et al. "Apparatus and Method for Repair of Perigraft Flow" devices and methods are directed to substantially different subject matter than either of the Simpson et al. or Preissman et al. patents. Their combination, as the Examiner proposes, can only be attributable to hindsight reconstruction, using Applicant's specification and claims as a guide. This is improper. See Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1350, 1358 (Fed. Cir. 1998).

Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 1 and 3-6.